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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,425	06/12/2001	Paul J. Thompson	11576.38USC1	6175

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Attention of David G. Schmaltz  
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P.O. Box 2903  
Minneapolis, MN 55402-0903

EXAMINER

MILLER, CHERYL L

ART UNIT	PAPER NUMBER
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3738

19

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/879,425

Applicant(s)

THOMPSON, PAUL J.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-12, 19-23, 29, 31-39 and 41-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 29, 31-37 and 45 is/are allowed.
- 6) ☒ Claim(s) 8-9, 11-12, 19-22, 38-39, and 41-44 is/are rejected.
- 7) ☒ Claim(s) 10 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 8-12, 19-23, and 29-44 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8, 9, 11, 12, 19, 21, 22, 41, 42, 43, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Alt (USPN 6,217,607 B1, cited previously). Referring to claims 8 and 9, Alt discloses an intraluminal stent (10, fig.1) comprising a stent body including a base material (15; col.4, lines 50-56; col.6, lines 4-11) having an un-deployed orientation and an enlarged orientation, sized to be balloon expanded (col.3, lines 5-8), the stent body having a stent axis extending between first and second ends (fig.1), the stent body also having an exterior surface and an interior surface, wherein the interior surface includes a portion having a rough surface finish wherein the rough surface finish includes portions removed from the base material (Alt discloses the entire, interior and exterior surfaces being roughened, and discloses in an alternative to coating the base stent, electropolishing a rough surface on the base stent, or providing a rough metal tubing then cutting the stent structure, both having rough surfaces on the base material instead of a coating col.9 line 64-col.10 line 9).

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Referring to claims 11-12 and 21-22, Alt discloses the portion including first and second portions of the rough surface finish disposed on opposite sides of a center of the stent body (pits, thus the rough surface is present at both ends of the interior surface, see figures 1, 3). Alt discloses first and second rough surface portions extending along the entire axial length of the body, the rough surface finish covering a majority of the interior surface of the stent body, and the rough surface finish completely surrounding an axis of the stent body (fig. 1, 3; rough surface is on all exposed surfaces of the stent, col.4, lines 1-5, 18-28).

Referring to claim 19, Alt discloses the rough surface finish including pits (fig.3; col.9 line 64-col.10 line 9).

Referring to claims 41-44, Alt discloses a stent body having a base material (15) having an interior and exterior surface, the interior surface having a rough surface finish including pits in the metal base material (col.4, lines 50-56; col.9, line 64 - col.10, line 8).

Claims 8, 9, 11, 12, 19, 20, 21, 22, 38, 39, 41, 42, 43, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Yan (USPN 5,843,172, cited previously). Referring to claims 8 and 9, Yan discloses an intraluminal stent (12; fig.1) comprising a stent body including a base material having an un-deployed orientation and an enlarged orientation, sized to be balloon expanded (col.8, lines 1-3), the stent body having a stent axis extending between first and second ends (fig.1), the stent body also having an exterior surface (86, 112) and an interior surface (84, 110), wherein the interior surface (84, 110) includes a portion having a rough surface finish (pits 18 create a rough surface, see figures 10, 12), wherein the rough surface finish includes portions removed from the base material. It is noted to the applicant, that the

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removal of portions from the base material is a method step within a product claim, making the claims a product by process claim. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). So, even though Yan's stent may have been made by sintering metal particles, upon sintering, voids are formed within the base metal, and therefore, the "portions removed" are present as voids in Yan's stent base material, forming the same end product as the product claimed. Even though Yan uses a different method of production, the same end product is formed, a stent having a base material, with portions of base material not present (voids 18).

Referring to claim 11, Yan discloses the portion including first and second portions of the rough surface finish disposed on opposite sides of a center of the stent body (pits, thus the rough surface is present at both ends of the interior surface, see figures 1, 10, 12).

Referring to claims 12 and 21-22, Yan discloses first and second rough surface portions extending along the entire axial length of the body, the rough surface finish covering a majority of the interior surface of the stent body, and the rough surface finish completely surrounding an axis of the stent body (see figures 1, 10, 12).

Referring to claims 19-20, Yan discloses the rough surface finish including pits (18) approximately 3-20 microns in size (col.3, lines 66-67).

Referring to claims 41-44, Yan discloses the stent body having a metal base material (col.4, lines 32-38), wherein the rough surface finish includes depressions or pits (18) in the metal base material.

Referring to claims 38-39, Yan discloses the rough surface finish configured to resist an undesirable biologic response such as undue thrombus formation or platelet activation (pits may include drugs to do so, col.5, lines 1-5).

***Allowable Subject Matter***

Claims 1-3, 29, 31-37, and 45 are allowed.

Claims 10 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

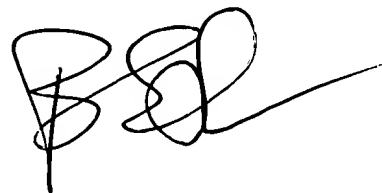
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



BRUCE SNOW  
PRIMARY EXAMINER